

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant	: Takashi Tsuji et al.	Art Unit	: 1644
Patent No.	: 7,166,283	Examiner	: Ilia I. Ouspenski
Issue Date	: January 23, 2007	Conf. No.	: 8893
Serial No.	: 10/625,105		
Filed	: July 22, 2003		
Title	: METHODS OF TREATING AN INFLAMMATORY DISORDER AND INHIBITING PROLIFERATION, CYTOKINE PRODUCTION, AND SIGNAL TRANSDUCTION WITH AN ANTIBODY AGAINST COSTIMULATORY SIGNAL TRANSDUCTION MOLECULE AILIM		

Commissioner for Patents
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APPLICATION FOR PATENT TERM ADJUSTMENT UNDER 37 C.F.R. § 1.705(d)

Patentee hereby requests reconsideration of the Patent Term Adjustment (PTA) accorded the above-referenced patent. This application is being filed together with a petition under 37 C.F.R. § 1.183 for a suspension of the two month time limit specified under 37 C.F.R. § 1.705(d).

Reconsideration of the final PTA calculation to increase total PTA from 419 to 604 days, is respectfully requested.

REMARKS

“A Delays” are defined as delays by the U.S. Patent and Trademark Office (PTO) under 35 U.S.C. § 154(b)(1)(A), which guarantees prompt PTO response. “B Delays” are defined as delays by the PTO under 35 U.S.C. § 154(b)(1)(B), which guarantees no more than three year application pendency. To the extent that the periods of delay overlap, the period of any term adjustment shall not exceed the actual number of days the issuance of the patent was delayed. 35 U.S.C. § 154(b)(2)(A). As outlined in Wyeth et al. v. Jon W. Dudas (U.S. District Court, D.C., CA No. 07-1492, Mem. Op. September 30, 2008), the only way that these periods of time can “overlap” is if they occur on the same day. If an “A delay” occurs on one calendar day and a

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“B delay” occurs on another calendar day, they do not overlap and 35 U.S.C. § 154(b)(2)(A) does not limit the extension to one day. Id.

The PTA for the instant patent, as currently calculated and shown on the face of the patent, apparently relies on the premise that the application was delayed under 35 U.S.C. § 154(b)(1)(B) *before* the initial three-year period expired. The Wyeth v. Dudas court determined that this construction cannot be squared with the language of 35 U.S.C. § 154(b)(1)(B), which applies “if the issue of an original patent is delayed due to the failure of the United States Patent and Trademark Office to issue a patent within 3 years.” “B delay” begins only after the PTO has failed to issue a patent within three years, not before. Id.

REVIEW OF PATENT TERM ADJUSTMENT CALCULATION

“A Delay”

A first PTO action was due on or before September 22, 2004 (the date that is fourteen months after July 22, 2003, the date on which the application was filed). The PTO mailed the first non-final Office Action on November 15, 2005, thereby according a PTO Delay of 419 days. Patentee does not dispute the PTO’s calculation for this “A Delay” from September 23, 2004 (the day after the date that is fourteen months after the date on which the application was filed), to November 15, 2005. See 37 C.F.R. §§ 1.702(a)(1) and 1.703(a)(1).

In view of the period of “A Delay” detailed above, the total “A Delay” for this patent should be calculated as 419 days.

“B Delay”

The period beginning on July 23, 2006 (the day after the date that is three years after the date on which the application was filed), and ending January 23, 2007 (the date the patent was issued), is 185 days in length.

In view of the period of "B Delay" detailed above, the total "B Delay" for this patent should be calculated as 185 days. The PTO calculated 0 days of delay for issuance of a patent more than three years after filing. Patentee respectfully submits that the PTO's calculation of this "B Delay" is incorrect and that the correct PTO Delay for issuance beyond three years from filing is 185 days. See 37 C.F.R. §§ 1.702(b) and 1.703(b).

Overlap of "A Delay" and "B Delay"

As detailed above, "A Delay" accumulated during the following period:

September 23, 2004, to November 15, 2005.

As detailed above, "B Delay" accumulated during the following period:

July 23, 2006, to January 23, 2007.

The "A Delay" and the "B Delay" overlap (i.e., occur on the same calendar day) for a total of 0 days.

Applicant Delay

There were no circumstances constituting a failure to engage in reasonable efforts to conclude processing or examination of the application as set forth 37 C.F.R. § 1.704.

Terminal Disclaimer

This patent is not subject to a terminal disclaimer.

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Conclusion

In consideration of the events described above, Patentee believes the PTA calculation of 419 days is incorrect. As such, Patentee respectfully requests reconsideration of the PTA in the following manner:

- 1) Total PTO Delay should be calculated as 604 days (i.e., the sum of 419 days of "A Delay" and 185 days of "B Delay" minus the 0 days of overlap);
- 2) Total Applicant Delay should be calculated as 0 days; and
- 3) Total PTA should be calculated as 604 days.

Please apply the fee of \$200 required under 37 C.F.R. § 1.18(e) and any other required charges or credits to Deposit Account No. 06-1050, referencing Attorney Docket Number 14539-0006002.

Respectfully submitted,

Date: January 22, 2009

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